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| 10/552,531 | 07/13/2006 | Ray Davenport | 205666-5040-00-US(455390) | 4385 |

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| EXAMINER |
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GREEN, ANTHONY J

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| ART UNIT | PAPER NUMBER |
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1793

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09/27/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DBRIPDocket@dbr.com
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|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/552,531 | Applicant(s) DAVENPORT ET AL. | |
| | Examiner Anthony J. Green | Art Unit 1793 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,9,10 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,9,10 and 12-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>09/15/08 & 10/28/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment submitted on 15 September 2008. After entry of the amendment claims 1, 4-7, 9-10, and 12-14 are currently pending in the application.
2. Based on applicant's amendments and arguments the previously made art rejections are withdrawn by the examiner and new rejections appear below.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 10 and 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims are vague and indefinite as they depend from claim 2 which is a canceled claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4-7, 9-10, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luebke et al (US Patent No. 5,800,870 A) in view of Japanese Patent Specification No. JP60-215895 A.

In the following rejection it is assumed that claims 10 and 12-14 should be dependent on claim 1, since claim 2 has been canceled, and accordingly they have been treated as such.

Luebke et al teaches a method of coating paper by applying a paper coating composition comprising a binder and a pigment. The binder comprises a stable aqueous dispersion comprising a water insoluble component and a water soluble component such that the water insoluble component comprises coalescable polymer particles which have a T_g less than 55°C. and a majority of which have a particle size less than 1 micron; and the water soluble component comprises a water soluble polymer capable of inhibiting coalescence of said polymer particles, or a water soluble polymer and a component capable of inhibiting coalescence of said polymer particles; and wherein said water insoluble component comprises greater than 3% and less than 75% by weight of the binder solids and said water soluble component comprises greater than 25% and less than about 97% of said solids. According to column 5, lines 50+ the pigments useful include clay, calcium carbonate, plus others known in the art. Column 6, lines 4+, recite the ranges of the amounts of the components. Column 5, lines 60-64 and column 6, lines 45+ teaches that starches and polymer latex emulsions may also be used as the binder.

Japanese Patent Specification No. JP60-215895 A teaches a paper coating composition which comprises a pigment, cationic dispersant, water soluble polymer and a cationic polymer.

The instant claims are obvious over the combination of the references. As for claims 1, 5-7, 9-10 and 12-14 while the primary reference does not recite the use of an organic pigment it does teach that others known in the art may be utilized and since the secondary reference teaches that it is known to use organic pigments such as phthalocyanine to coat papers it would have been obvious to incorporate an organic pigment into the primary reference without producing any unexpected results and thus arrive at the instant invention absent evidence showing otherwise. The claim would have been obvious because "a person of ordinary skill has good reason to pursue the known options with his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense." A predictable use of prior art elements according to their established functions to achieve a predictable result is prima facie obvious. See *KSR Int'l Inc. v. Teleflex Inc.*, 127 S Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007). Accordingly the use of any organic pigment in the primary reference would have been obvious to one of ordinary skill in the art absent evidence showing otherwise. As for claim 4 the reference teaches that polymer latex emulsions may also be used as the binder and accordingly it would have been obvious to utilize any polymer latex such as one derived from diene and/or unsaturated monomers as the binder without producing any unexpected results absent evidence showing otherwise.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Specification No. JP60-215895.

The reference teaches a paper coating composition which comprises a pigment, cationic dispersant, water soluble polymer and a cationic polymer. The pigment may be an organic pigment such as phthalocyanine and the cationic polymer may be selected from SBR latex etc.

The instant claim is obvious over the reference as the reference provides the motivation to produce the instant composition. As for the amounts of the components the reference teaches amounts that encompass or overlap the claimed amounts. One of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the compositional proportions taught by the reference overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

“The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages”, In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matuki (US Patent Application Publication No. 2005/0250891 A1).

The reference teaches, in the abstract and the claims, a water based paint comprising water based rubber latex, an inorganic or organic pigment, and at least one selected from the group consisting of a vulcanizing agent, a vulcanizing accelerator and a vulcanizing aid. According to paragraph [0015] the rubber latex can be butadiene rubber etc. According to paragraph [0017] the organic pigment can be any conventionally used such as phthalocyanine and the pigment may be used in the amount of 20 to 200 parts by weight with respect to 100 parts by weight of the rubber.

The instant claim is obvious over the reference as the reference provides the motivation to produce the instant composition. While the reference does not recite that the composition is for controlling the bleed fastness this is an intended use limitation. Ultimate utility does not make a composition patentable. That is, the future use of a composition adds little or no patentable weight to a composition claim when the composition is the same (In re Pearson 181 USPQ 641). Patentability does not depend upon intended use (Ex parte Wikdahl 10 USPQ2d 1546). As for the amounts of the components the reference teaches amounts that encompass or overlap the claimed amounts. One of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the compositional proportions taught by the reference overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious

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to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

“The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages”, In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

Accordingly the instant claim is obvious over the reference.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rajaraman (US Patent No. 6,500,896 B1).

The reference teaches, in column 1, lines 64+), a latex based colorant comprising 5-50 percent of a latex based binder, 10-70 percent of a pigment (inorganic or organic) and 0-85 percent water. According to column 2, lines 13-15, the latex may be a styrene butadiene rubber etc. According to column 2, lines 29+, the organic pigment may be selected from various organic pigments such as phthalocyanine, Red Lake C, Carbazole violet, rhodamine red etc.

The instant claim is obvious over the reference as the reference provides the motivation to produce the instant composition. While the reference does not recite that the composition is for controlling the bleed fastness this is an intended use limitation. Ultimate utility does not make a composition patentable. That is, the future use of a

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composition adds little or no patentable weight to a composition claim when the composition is the same (*In re Pearson* 181 USPQ 641). Patentability does not depend upon intended use (*Ex parte Wikdahl* 10 USPQ2d 1546). As for the amounts of the components the reference teaches amounts that encompass or overlap the claimed amounts. One of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the compositional proportions taught by the reference overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

“The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages”, *In re Peterson* 65 USPQ2d 1379 (CAFC 2003).

Also, *In re Geisler* 43 USPQ2d 1365 (Fed. Cir. 1997); *In re Woodruff*, 16 USPQ2d 1934 (CCPA 1976); *In re Malagari*, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

Accordingly the instant claim is obvious over the reference.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is (571)272-1367. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry A. Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Anthony J Green/
Primary Examiner
Art Unit 1793

ajg
September 22, 2010